

REMARKS

After entry of the RCE, Applicants reply to the Advisory Action dated September 9, 2010, and further reply to the final Office Action dated July 6, 2010. Claims 1, 3, 5, 6, and 9-14 were pending in the application and the Examiner rejects claims 1, 3, 5, 6, and 9-14. Support for the claim amendments may be found in the originally-filed specification, claims, and figures, and specifically, for example, paragraph 147. No new matter is entered by these claim amendments. Applicants respectfully request reconsideration of this application.

In the Office Action dated July 6, 2010, the Examiner rejects claims 1, 3, 5, 6, and 9-14 under 35 U.S.C. § 103(a) as being unpatentable over Taylor, U.S. Patent Application No. 5,578,808 (“Taylor”), in view of Russell et al., U.S. Patent Application Pub. No. 2004/0044627 (“Russell”), and further in view of Fisher, U.S. Patent Application Pub. No. 2002/0040438 (“Fisher”).

In the Advisory Action and in response to Applicants’ remarks in the Office Action Reply, the Examiner asserts that “the features upon which applicant relies (i.e., “a user could select the percentages from specified accounts during a transaction”) are not recited in the claims. The Examiner goes on to state that Russell discloses the user selecting an account during a transaction (para. 225) and that Russell discloses payer account data specifying “that a certain percentage of the payment be funded from a specified checking account and the balance be funded from a specified credit-card account,” (para. 37). The Examiner contends that these two aspects combine to make it obvious that a user can select two accounts with various percentages during a transaction. Applicants respectfully disagree. However, in order to expedite prosecution and to further clarify the patentable aspects of the claims, Applicants amend the independent claims.

In general, with respect to funding a transaction, Russell discloses that the payer account data specifies whether a single account or a set of accounts may fund the transaction, and a certain percentage of the payment to be made from the various accounts. One provided example is the payer account data specifying a certain percentage of the payment be funded from a specified account and the balance be funded from a specified credit-card account. (Russell, para. 37). However, Russell does not disclose the selection of an account to fund a transaction, where the selection is part in part on the goods or services involved in the transaction. In other words,

Russell does not disclose associating various accounts with various types of transactions. None of the other cited references account for this deficiency.

Applicants assert that none of the cited references disclose or contemplate “[a] method for managing a plurality of data sets on a radio frequency (RF) transaction device, the method comprising:.... providing information relating to the first data set and the second data set for selection, **wherein the information includes the first data set and the second data set being associated with transaction categories; determining a selection of at least one of the first data set and the second data set based in part on a preference of data set use and a transaction category of a transaction request,**” as recited in independent claim 1 (emphasis added), and as similarly recited in independent claim 9.

Claims 3, 5, 6, and 10-14 variously depend from independent claim 1, so claims 3, 5, 6, and 10-14 are thus differentiated from the cited references for the same reasons stated above for differentiating claim 1, in addition to their own respective features. Applicants therefore respectfully request withdrawal of the rejections of claims 3, 5, 6, and 10-14.

Also in the Advisory Action, the Examiner asserts that under 37 C.F.R. §1.111(b)¹ Applicants have waived their right to argue certain limitations at this later time in prosecution. The Examiner states that “[u]nder 37 CFR 1.111(b), Applicants should have argued this specific limitation in their first reply after Taylor was first asserted by the Examiner to meet the limitation ‘the first format is different from the second format.’” For support, the Examiner cites *In re Goodman, 3 USPQ2d 1866 (1987 Commr. Pat. LEXIS 12)*.

Although the Examiner argues that Applicants have waived their right to argue specific elements at this time, the Examiner’s reliance upon *In re Goodman, 3 USPQ2d 1866*, for this proposition is misplaced. In Goodman, the Applicants’ response to the Final Office Action did not refer to the rejection under the first paragraph of §112. The Commissioner held that the patent application in question was abandoned for failure to properly respond to the first Office

¹ 37 C.F.R. §1.111(b) - “The reply by the applicant or patent owner must be reduced to a writing which distinctly and specifically points out the supposed errors in the examiner's action and must reply to every ground of objection and rejection in the prior Office action. The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references... The applicant's or patent owner's reply must appear throughout to be a bona fide attempt to advance the application or the reexamination proceeding to final action. A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.”

Action. "The response to the first Office action in this case was totally lacking in even a minimal attempt to 'specifically point out the supposed errors in the examiner's action,'" (Goodman, 7-8).

A ground of objection or rejection as used in 37 C.F.R. §1.111(b) refers to rejections such as lack of proper disclosure, lack of enablement, indefiniteness, lack of novelty, or lack of non-obviousness. (See MPEP §707.07(d) & (g) for reference). In order for Applicants to reply to every ground of rejection in the prior Office Action, Applicants must present arguments pointing out specific distinctions between a claim and the rejection. Nothing in 37 C.F.R. §1.111(b) requires the Applicants to address each and every claim element asserted to be disclosed by a cited reference. In other words, Applicants have addressed the rejection of the claims by present arguments for patentability, and thus do not have to address each element of the claim in order to comply with 37 C.F.R. §1.111(b). Thus, Applicants request that the Examiner withdraw his assertion that the right to argue various limitations has been waived.

In view of the above remarks, Applicants respectfully submit that the pending claims properly set forth that which Applicants regard as their invention and are differentiated from the cited references. Accordingly, Applicants respectfully request withdrawal of the rejections of all claims. The Examiner is invited to telephone the undersigned at the Examiner's convenience, if that would help further prosecution of the subject application. The Commissioner is authorized to charge any fees due to Deposit Account No. 19-2814.

Respectfully submitted,

Date: Oct 6, 2010

By Adam J. Stegge
Adam J. Stegge
Reg. No. 63,297

SNELL & WILMER L.L.P.
One Arizona Center
400 East Van Buren
Phoenix, AZ 85004-2202
Phone: (602) 382-6306
Fax: (602) 382-6070
astegge@swlaw.com